

Remarks**Status of the Claims**

Claims 1-43 are pending in this application. Claims 18-31 stand rejected. Claims 1-17 and 32-43 are withdrawn from consideration under a restriction requirement. No claim is allowed.

1. Restriction Requirement Made Final:

Applicants previously elected Group IV, claims 18-31, drawn to a method for identifying a modulator of a *Lepidoptera* calcium channel protein activity.

2. Patentability Under 35 U.S.C. §101

Claims 18-31 stand rejected for a lack of utility. In the instant application, claims 18-31 are drawn to methods for identifying a modulator of a lepidoptera calcium channel protein activity. The claims are drawn to patentable subject matter.

35 U.S.C. §101 further requires that the claimed subject matter has utility. *Brenner v. Mason* (383 US 519 (1966)) is cited by the Office to support rejecting chemical compound claims 18-31 for lack of utility. It is true that the Court in *Brenner* did reach a holding on the patentability based on the utility requirement of the compound claims in contention. However, it specifically declined to reach beyond the issue before it to make a holding as to the patentability of method claims in *Brenner*. Applicants' claims currently under prosecution are not drawn to a chemical compound or composition. The holding in *Brenner* is not applicable to the present claims.

The USPTO Guidelines for Examination of Applications for Compliance with the Utility Requirement (MPEP 2107; hereinafter "Utility Guidelines") set out an analysis for utility. Applicants contend that the claimed methods possess utility sufficient under the Guidelines. The stated utility is not a "throw away utility", but is credible, substantial,

and specific under the Guidelines. The claims are particularly drawn to methods for identifying a modulator of a *Lepidoptera* calcium channel protein activity useful for controlling harmful organisms and in preventing infestation or damage caused by harmful organisms (see paragraph 1087). Support for Applicants' position is found in the specification at paragraphs 1056-1087, and in the Figures, particularly Figs 3-5.

The Utility Guidelines advise that a rejection based on lack of utility should not be maintained if an asserted utility for the claimed invention would be considered specific, substantial, and credible by a person of ordinary skill in the art in view of all evidence of record. In light of the above discussion, Applicants respectfully request the withdrawal of the rejection for lack of utility and reconsideration of the claims under consideration.

3. Patentability Under, 35 U.S.C. §112, first paragraph:

A. In light of Applicants' rebuttal of the rejection for lack of utility under 35 U.S.C. §101 and the procedure set out under the Utility Guidelines, the rejection under 35 U.S.C. §112, first paragraph, should be withdrawn.

Furthermore, as recently explained in the precedential opinion of *Ex parte Kubin* (PTO Bd. App., May 31, 2007), a rejection for lack of enablement on the basis of undue experimentation is not appropriate where the amount of experimentation to practice the full scope of the claimed invention would have been routine, even if extensive. Since, as shown above, the methods used to practice the full scope of Applicants' invention were routine as of the 8 November 2002 priority date, and even if extensive, the pending rejection for lack of enablement should be withdrawn. Experimentation to practice the claimed methods is not undue.

In light of the above discussion, reconsideration of claims 18-31, withdrawal of the rejection for lack of enablement, and allowance are respectfully requested.

B. Claims 18-31 comply with the standards of 35 USC §112, first paragraph.

The written description requirement of 35 USC §112 concerns how to make and use the claimed invention. Traditional analysis looks to whether the Applicant “had possession” of the claimed genus as of the filing date of the application. This is a factual inquiry, intended to exclude extending the scope of the claim to subject matter exceeding a “reasonable correlation” with the scope of disclosure. The written description complies with § 112 if a person of ordinary skill in the art would be expected to use the claimed subject matter.

Applicants have sufficiently enabled the claimed subject matter. Therefore, Applicants also satisfied the written description requirement. (See *Lizardtech v. Earth Resource Mapping*, 424 F3d 1336, 1334-45, (CAFC 2005).) At the time Applicants’ application was filed the level of skill in the art of molecular biology was high. Methods of making the claimed nucleic acid sequences and screening for activity were well known in the art and described in the specification. Applicants disclosed a full length nucleotide sequence of the isolated nucleic acid. They also disclosed a full length polypeptide encoded by the disclosed nucleotide sequence. The claims are supported by disclosures as set out above.

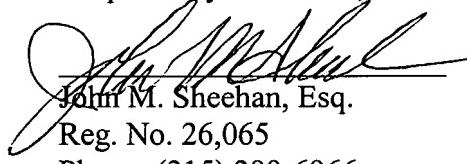
Conclusion

In view of the foregoing, Applicants respectfully assert that the independent claim patentably defines the present invention. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Therefore, Applicants request reconsideration, withdrawal of the rejections, and early allowance of the presented claims. Separate and individual consideration of the dependent claims is respectfully requested.

Petition For Extension Of Time In Which To Answer

Authorization is hereby made to charge the amount of \$450.00 for a two-month extension of the response time to Deposit Account No. 06-1440. Please consider this authorization as a petition for an extension of time. Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

Respectfully submitted,



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